

REMARKS

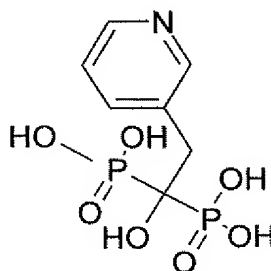
Claim Rejections Under 35 USC § 103

The Office Action points to a compound in the prior art, i.e., in US '250, and alleges that said compound differs from the claimed compounds in the placement of the methyl and sec-butyl substituents on the phenyl ring that is directly attached to the chiral group, and thereby said compound and the claimed compounds are ring isomers.

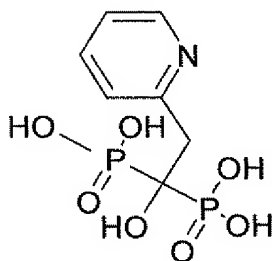
The Office Action then provides a quote (uses quotation marks) allegedly from *In re Jones*, 162 F.2d 638, 74 USPQ 152 (CCPA 1947). The quoted language however does not appear in *Jones*. Moreover, no such broad *per se* holding as present in the quoted language is in any case known to applicants. Thus, reliance on said material is improper.

Instead, applicants bring attention to the recent (decision of May 13, 2009), highly relevant decision by the Federal Circuit, i.e., *Procter and Gamble vs TEVA Pharmaceuticals*, 90 USPQ2d 1947 (Fed. Cir. 2009).

In *Procter and Gamble*, the issues under section 103 related to a patent claiming the compound risdronate, whose structure is the following:



A reference patent lists thirty-six polyphosphonate molecules as treatment candidates including 2-pyr EHDP, 2-(2-pyridyl)-1-hydroxy-ethane-1,1-diphosphonic acid, whose structure is the following:



Risedronate (the claimed compound) and 2-pyr EHDP (the reference compound) are positional isomers. In risedronate, the hydroxy-ethane-diphosphonate group is connected to the #3 carbon of a pyridine ring, while in 2-pyr EHDP; the hydroxy-ethane-diphosphonate group is connected to the #2 carbon.

The Federal Circuit held that under *KSR v. Teleflex*, 550 U.S. 398, 82 USPQ2d 1385 (2007), “it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound.”

Citing *Takeda Chem. Indus. v. Alphapharm*, 492 F.3d 1350, 83 USPQ2d 1169 (Fed. Cir. 2007), which post dates *KSR* also, the Federal Circuit held that an obviousness argument based on structural similarity between claimed and prior art compounds clearly depends on a preliminary finding that one of ordinary skill in the art would have selected the prior art compound as a lead compound.

In the present case, nothing in the Office Action even remotely indicates why one of ordinary skill in the art would have even considered the identified compound O as a potential lead compound. US ‘250 teaches by structure compounds A through R. Additional compounds exemplified are compounds of examples 1, 3 and 5, but these are not provided by structure. The compound of example 1, and compounds A, C, G and P are tested in examples 7-10 for performance as light protecting agents. Compound O is not tested for performance. Based on the disclosure of US ‘250, one of ordinary skill in the art would not have been led to compound O as the lead compound. Without such a preliminary finding, one of ordinary skill in the art would not have had the opportunity to consider possible modifications to said compound O. And for this reason alone even, there should be no finding of obviousness.

The court in *Procter and Gamble* noted that to successfully argue that a new compound is obvious, one may show “that the prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention.” In keeping with the flexible nature of the obviousness inquiry, the requisite motivation [to modify] can come from any number of sources. Thus, in addition to structural similarity between the compounds, a prima facie case of obviousness may be shown by “adequate support in the prior art” for the change in structure. Citing *Takeda*, the Federal Circuit stated:

A known compound may suggest its homolog, analog, or **isomer** because such compounds often have similar properties and therefore chemists of ordinary skill would ordinarily contemplate making them to try to obtain compounds with improved properties. . . . [However,] **it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner** to establish prima facie obviousness of a new claimed compound. (Emphasis added.)

The Office Action does not identify any reason why one of ordinary skill in the art would have modified compound O in US '250 in such a way so as to achieve a compound within the scope of the present claims.

The modifications required are not even generally taught or suggested by the cited prior art. None of the compounds in US '250 have a methyl or sec-butyl substituent in the positions 3' and 5'. All compounds in the 3' and 5' positions are unsubstituted in all cases, and are unsubstituted at said positions even in the general formula taught on column 1.

Moreover, there is no reason provided why one of ordinary skill in the art would have made these two particular modifications out of the many possible others. For example, it has not been established why would one find it obvious to move 2 substituents to new positions versus 1, 3, 4, 5 or 6 (see the 5 R groups and the OH group in the general formula on column 1 as substituents on the compounds of the reference, and the corresponding substituents in compound O). Additionally, there is no reason provided why the groups corresponding to R₃ and R₅ in the reference compound O should be moved to a new position, and not any other substituents on said compound.

As such, the Office Action has not established that the claimed compounds are obvious over the cited art.

Reconsideration is respectfully and courteously solicited.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Csaba Henter/

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